

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Helmut Thoma

GROUP: 3682

SERIAL NO: 10/647,912

EXAMINER: Terence Boes

FILED: August 25, 2003

FOR: GEAR ARRANGEMENT

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

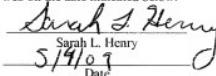
REPLY

Entry of this Reply is respectfully requested in order to address several new issues raised in the Examiner's Answer.

First, the Examiner's Answer states "*[i]n this the examiner again agrees with the Appellant, that is to say, the examiner agrees the gears of Shinichi are indeed axially detached.*" (Examiner's Answer, pg. 11). It is respectfully submitted that the Examiner's Answer is misrepresenting the record – the applicant **does not agree** that the gears in Shinichi are indeed axially detached. A key point in the appeal is that Shinichi fails to teach the claimed feature of "*wherein the first and second gear are arranged on the shaft axially detached from one another.*" (*cl. 1, emphasis added*).

Second, the Examiner's Answer states "*one of ordinary skill in the art would not, at first, recognize Appellant's own gears as being 'axially detached' (as Appellant's own drawings*

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Sarah L. Henry
5/19/07
Date

clearly show the gears to be immediately adjacent). Thus one of ordinary skill must look further to ascertain the meaning of the term ‘detached’.” (*Examiner’s Answer, pgs. 11-12*). It is respectfully submitted that the figures clearly show this claimed feature. The issues on appeal are patentability in view of prior art, not 35 U.S.C. 112, second paragraph issues.

Third, it is worth noting that the Examiner’s Answer admits that he is merely providing a functional description of the prior art in attempt to support his anticipation rejection (see Examiner’s Answer, pg. 12, lines 11-15). In assessing the issues on appeal, it is fundamental that the Examiner clearly state what a fair and proper reading of Shinichi teaches. However, in this case the Examiner admits he cannot, and is turning to a functional description of the gear of Shinichi. A gear is best described structurally, not functionally as the Examiner’s Answer attempts to do after avoiding the necessary structural analysis of Shinichi in order to assess what it properly teaches. Shinichi must disclose each and every structural feature of the claimed apparatus invention in order to anticipate; it is submitted that the Examiner is not carrying his burden when he admits that he must rely upon a functional description of Shinichi rather than a structural description.

Finally, the Examiner’s Answer fails to properly consider the claimed invention as a whole. Specifically, in attempting to respond the arguments in the Appeal, the Examiner’s Answer states that if something is “immediately adjacent” then it is “axially detached”. (see Examiner’s Answer, pg. 12, lines 11-15). It is respectfully submitted that the claimed invention must be considered, not some attempted paraphrased and incorrect variant thereof.

CONCLUSION

The rejection of claims 1, 11-14, 18 and 19 is erroneous and reversal thereof is respectfully requested.

If there are any additional fees due in connection with the filing of this amended appeal brief, please charge them to our Deposit Account 50-3381. If a fee is required for any extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should be charged to the above Deposit Account.

Respectfully submitted,

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